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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/782,590	02/18/2004	Ewald Mothwurf	089194-000100US	4750

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SAN FRANCISCO, CA 94111-3834

EXAMINER
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NGUYEN, KIM T

ART UNIT	PAPER NUMBER
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3714

MAIL DATE	DELIVERY MODE
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06/12/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/782,590

**Applicant(s)**

MOTHWURF ET AL.

**Examiner**

Kim T. Nguyen

**Art Unit**

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 47-90 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 47-90 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 09/761,439.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

The amendment filed on 3/26/07 has been entered. By this amendment, claims 1-46 have been canceled, claims 47-90 have been added, and claims 47-90 are now pending in the application.

### ***Claim Objections***

1. Claims 62, 69 and 81-83 are objected to because of the following informalities:

Claim 62:

line 2, the claimed limitation "a plurality of players" should be corrected to "said players".

Claim 69:

line 1, the claimed limitation "the allocation" should be corrected to "an allocation".

line 13, the claimed limitation "a result" should be corrected to "said result".

line 14, the claimed limitation "the transfer" should be corrected to "a transfer".

line 15, the claimed limitation "a said gaming position" should be corrected to "said".

lines 16-17, the repeated limitation "to at least one player associated with a said gaming position which triggered the winning result" should be deleted.

Claim 81:

line 1, the claimed limitation "the allocation" should be corrected to "an allocation".

line 12, the claimed limitation "a said win" should be corrected to "said win".

line 21, the claimed limitation "a winning entry" should be corrected to "said winning entry".

line 22, the claimed limitation "players" should be corrected to "said players".

Claim 82:

line 1, the claimed limitation "A method of testing" should be corrected to "A method of operating".

line 2, the claimed limitation "the network" should be corrected to "the computer network".

Claim 83:

line 1, the claimed limitation "A method of testing" should be corrected to "A method of operating".

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 51, 52 and 82 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 51, lines 12-13 and 15-16, the phrases "[such as ...]" and "[and/or...]", respectively render the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

In claim 52, lines 4-5, the phrase "[sound, light, ...]" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

In claim 82, line 4, the claimed limitation "the results" is ambiguous. It is not clear if the results refer to the results from the testing communication channels in claim 82, line 2, or the results from the checking whether the selection generated constitutes a winning entry in claim 81, line 20. Further, "the results" lacks of antecedent basis.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**5. Claims 47- 90 are rejected under 35 U.S.C. 103(a) as being unpatentable over Acres (U.S. patent No. 6,371,852) (Acres '852) in view of Acres et al (U.S. Patent No. 5,752,882) (Acres '882) and Olsen (U.S. Patent No. 6,217,448).**

Regarding to claims 47-50, 52-54, 61, 66 and 68, Acres '852 discloses a jackpot system for an allocation of wins from at least one jackpot to players playing at a plurality of gaming positions. The jackpot system comprises a computer network associated with the gaming positions (col. 3, lines 7-16), a computing engine included in the computer network and having a memory for receiving inputs from the gaming positions and at least one output for communicating information to the players at the gaming positions (col. 5, lines 10-31), a pay table associated with the jackpot having a plurality of possible winning entries and respective wins associated with each of the winning entries (col. 7, lines 55-61). Acres '852 does not explicitly disclose a selection generator and a means for comparing the generated selection with the pay table. However, since Acres '852 discloses reel slot game machines (Fig. 2; col. 6, lines 42-43), and since it would have been well known that when activate the spin button of the slot game machine, an outcome is randomly selected and is compared with the winning entries of a pay table, Acres '852 obviously encompasses the well-known selection generator for generate a selection outcome and means to compare the selected outcome with the winning entries of the game table as claimed. Acres '852 does not explicitly disclose that the pay table is capable of being configured by an operator. However, Acres '882 discloses configuring the pay table in accordance with the reconfiguring command (col. 3, lines 3-12), and Olson discloses allowing the operator to configure the pay table associated with the jackpot (col. 13, lines 51-54; and col. 22, lines 9-15). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the pay table associated with the

jackpot being capable of being configured by an operator as taught by Acres' 882 and Olsen to the jackpot system of Acres' 852 in order to allow the operator to control paybacks of the jackpot game system.

Regarding to claim 51, Acres '852 discloses inputting the amount bet at a gaming machine (col. 5, lines 10-20).

Regarding to claims 55-60: using a random number generator used in conjunction with a counter to receive seed numbers from the counter, and varying the probability of winning in response to amount of bet, or in response to time of day would have been well known to a person of ordinary skill in the art at the time the invention was made.

Regarding to claim 62, Acres '852 discloses transferring wins to a plurality of gaming stations (col. 7, lines 51-64).

Regarding to claims 63-65, Acres '852 discloses depositing a portion of wager to the jackpot (col. 7, lines 43-44). Further, as to claim 65, winning of one jackpot will trigger into a further jackpot game would have been well known to a person of ordinary skill in the art at the time the invention was made.

Regarding to claim 67: implementing a duplicating system to double check the accuracy of the main system would have been well known to a person of ordinary skill in the art at the time the invention was made.

Regarding to claims 69-83, refer to discussion in claims 47-68 above.

Regarding to claim 84: Acres '882 discloses wherein an item of information relating to the identity of the gaming position comprises an identification of a slot machine (col. 10, lines 56-57; and col. 16, lines 50-56).

Regarding to claim 85, Acres '882 discloses wherein an item of information relating to a player attribute comprises player name or membership of a group (col. 27, line 56; and col. 14, lines 4-5).

Regarding to claim 86, Acres '852 discloses wherein an item of information relating to player activity level comprises rate of play (col. 5, lines 19-20).

Regarding to claim 87, Olsen discloses wherein an item of information relating to an external event comprises a manual input from an operator (col. 13, lines 51-53).

Regarding to claim 88, Olsen discloses wherein the indicator comprises a loudspeaker (col. 5, lines 54-67).

Regarding to claim 89, relating a win to a jackpot amount via the size of bet would have been well-known and obvious matter of design choice.

Regarding to claim 90, Acres '882 discloses a plurality of slot machines are adjacent connected to an associated floor controller over a network (Fig. 1), Acres '882 obviously discloses an associated player at an adjacent slot machine.

### ***Response to Arguments***

6. Applicant's arguments filed 3/26/07 have been fully considered but they are not persuasive.

In response to applicant's argument in page 20, last paragraph, through page 21, second paragraph, Acres' 852 teaches a jackpot system comprises a plurality of gaming machines interconnected over the network to a bank controller, pay tables on each gaming machine (col. 3, lines 7-27 and 56-59), and a jackpot is dictated the



gaming machine's pay table (col. 7, lines 59-60). Since the gaming machines, pay tables and jackpot awards are included in the jackpot system, Acres' 852 clearly teaches that the pay table involved is the pay table associated with the jackpot of the jackpot system as claimed. Acres' 852 discloses a jackpot dictated by a pay table of a gaming machine (col.7, lines 59-60). The jackpot is not dictated by the machine at the pay table as asserted by the applicant. It is also noted that applicant argues on the features such as a jackpot system operating with a pay table, way of configuring a pay table, gaming which is carried out at a jackpot system are not recited in the rejected claims.

In response to applicant's argument in page 21, third paragraph, Acres' 852 does not explicitly teach that the pay table is capable of being configured by an operator. However, the combination of Acres' 882 and Olsen clearly disclose the pay table is capable of being configured by an operator. Refer to the claim rejections 35 USC § 103 on claim 47 above.

In response to applicant's argument in page 21, fourth paragraph, through page 22, lines 1-5, that the Acres' 852 fails to disclose configuration of a jackpot system and Acres' 882 fails to disclose any information as to how the jackpots themselves are to be configured and organized. It is noted that the independent claims do not claim details such as configuration of a jackpot system, how the jackpots themselves are to be configured and organized as asserted.

In response to applicant's argument in page 22, first paragraph, that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it

Art Unit: 3714

must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action. Any response to this final action should be mailed to:

Box AF

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Or faxed to:

Art Unit: 3714

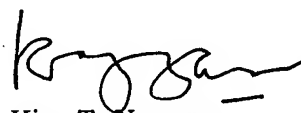
(571) 273-8300, (for formal communications; please mark "EXPEDITED PROCEDURE").

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim T. Nguyen whose telephone number is (571) 272-4441. The examiner can normally be reached on Monday-Thursday from 8:30AM to 5:00PM ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai, can be reached on (571) 272-7147. The central official fax number is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Date: June 5, 2007

  
Kim T. Nguyen  
Primary Examiner  
Art Unit 3714